UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/792,150	03/03/2004	Yossi Oulu	MERCURY.199DV2	4847

22879   7590   12/24/2008
HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER
COULTER, KENNETH R

ART UNIT	PAPER NUMBER
2441	

NOTIFICATION DATE	DELIVERY MODE
12/24/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
mkraft@hp.com
ipa.mail@hp.com

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-4_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-4_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a) ☐ All b) ☐ Some * c) ☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _7/2/04; 3/3/04_.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 6,792,460.

Although the conflicting claims are not identical, they are not patentably distinct from

each other because of the following mapping below.

Claim 1 of the present Application map to claims1, 7, and 8 (combined) of '460.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

Claims 1 – 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Hind et

al. (U.S. Pat. Pub. No. 2004/0054695) (Problem Determination Method, System and

Program Product).

1.1   Regarding claim 1, Hind discloses a method of instrumenting Java components

installed on an application server in order to enable the Java components to be

monitored, the method comprising:

adding a patch to a class loader class of a Java virtual machine installed on the

application server, wherein the patch causes the class loader class to pass Java

components to an instrumentation component when said Java components are loaded

by the Java virtual machine (Figs. 3, 5; Abstract "**inserting** compiled problem

determination **probes into program classes**"; paragraphs 36, 38);

receiving, from a patched version of said class loader class, code of a Java

component to be loaded by the Java virtual machine (Figs. 3, 5; Abstract; paragraph

38); and

with the instrumentation component, instrumenting said code of the Java

component to add functionality for tracking execution times (Figs. 3, 5; Abstract "Once

the probes have been inserted, **the classes will be run and trace data will be**

generated."; paragraph 38 "**inserting problem determination probes**").

Paragraph 38 in Hind

The present invention addresses the issues with related art systems by providing a scheme for
inserting problem determination probes into program classes while the subject system is
running. Specifically, under the present invention, the problem determination <u>probes are</u>
<u>injected into the runtime</u> of an object-oriented execution environment of a customer's system
that interprets and/or incrementally compiles an intermediate virtualized instruction
representation of that environment's object logic. One example of such an environment is JAVA
where the intermediate virtual instructions resulting from compilation of source instructions are
known as "bytecodes," which at run-time are loaded into a <u>Java Virtual Machine</u> (JVM) **by a**
class loader. Once loaded, the bytecodes are directly interpreted and/or incrementally compiled
by a just-in-time (JIT) compiler into native code for execution. It should be understood, however,
that although JAVA terminology will be used in the following description, the teachings
described herein could be applied in any environment.

1.2   Per claim 2, Hind teaches the method of claim 1, wherein instrumenting said

code comprises adding calls to each of a plurality of methods of the Java component, to

thereby provide functionality for monitoring execution times of said methods (Figs. 3, 5;

Abstract; paragraphs 10, 38).

1.3   Regarding claim 3, Hind discloses the method of claim 1, wherein instrumenting

said code comprises adding functionality for detecting when the Java component is

invoked by a colored transaction request message (Figs. 3, 5; paragraph 44 "the logic is

generated by parsing the rules to create a list of patterns that match all of the specific

classes that require the probes ...").

1.4   Per claim 4, Hind teaches the method of claim 1, wherein instrumenting said

code comprises adding functionality for reporting transaction identifiers of transactions

that invoke the Java component, to thereby allow said execution times to be associated

with transactions to which they correspond (Figs. 3, 5; Abstract; paragraph 38).

Conclusion

The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Holiday   U.S. Pat. No. 6,202,208   Patching Environment for Modifying a

JAVA Virtual Machine and Method

A JAVA patch for modifying a loader environment of a JVM (no tracking of execution

times) (Abstract; col. 5, lines 36 – 55).

Berry et al.   U.S. Pat. No. 6,738,977   Class Sharing Between Multiple Virtual

Machines

Blandy et al. U.S. Pat. No. 6,779,188   Apparatus and Method for Improved

Devirtualization of Method Calls

Bryant et al. U.S. Pat. No. 6,728,949   Method and System for Periodic Trace

Sampling Using a Mask to Qualify Trace Data

A method of monitoring execution performance in which instrumentation code can be patched and a trace record is generated. (Figs. 3B, 23; col. 26, lines 6 – 19).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on 571 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/
Primary Examiner, Art Unit 2441

/KRC/